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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ellis, *et al.*

Patent No.: 7,612,183

Issue Date: November 3, 2009

Serial No. 10/523,295

Group Art Unit No.: 1644

Filed: 3 February 2005

Examiner: G. Ewoldt

For: HUMANISED ANTI-MAG ANTIBODY OR FUNCTIONAL FRAGMENT THEREOF

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REQUEST FOR RECONSIDERATION OF PATENT TERM UNDER 37 CFR §1.705(d)

This is a request for reconsideration of patent term adjustment pursuant to 37 CFR §1.705(d), according to which the applicants may request reconsideration within two months from the date the patent issued if the patent indicates or should have indicated a revised patent term adjustment. Applicants respectfully seek 271 days of patent term adjustment in addition to the 244 days stated on the Issue Notification for a total of 515 days. Accompanying this request is the required processing fee set forth in 37 CFR § 1.18(e). The statement of facts supporting this request is set forth below pursuant to 37 CFR §1.705(b)(2).

Relevant Dates:

Priority Date: August 6, 2002

30th month ended: February 5, 2005

National stage commencement date: February 3, 2005

35 U.S.C. 371(c) completion date: February 3, 2005

3-year pendency ended: February 2, 2008

Request for Continued Examination (RCE) filed: December 3, 2008

Issue date: November 3, 2009

A delay

Under 35 U.S.C. § 154(b)(1)(A), the applicant is guaranteed prompt USPTO (hereafter “the Office”) responses. If the issue of an original patent is delayed due to the failure of the Office to engage in reasonable efforts to conclude prosecution, the term of the patent shall be extended in accordance with 37 CFR § 1.703(a), hereinafter referred to as A delay. Here, the A delay was calculated to be 475 days caused by the failure of the Office to engage in reasonable efforts to conclude prosecution. Applicants agree with the Office’s calculation.

B delay

Under 35 U.S.C. § 154(b)(1)(B), the applicant is guaranteed of no more than a 3-year application pendency. Delay caused by the failure of the Office to issue a patent within 3 years is assessed in accordance with 37 CFR § 1.703(b), hereinafter referred to as B delay. The term of a patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued, not including any delay in the processing of the application requested by the applicant.

“The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the the date on which the appliation was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:
(1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued;” 37 CFR 1.703(b)(1).

The starting date of the 3-year period is set forth in 35 U.S.C. 371(b): “Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2) or under article 39(1) of the [PCT] treaty.” According to the above, the national stage of the present application commenced on February 3, 2005, and the 3-year pendency ended on February 2, 2008. The total B delay is the period beginning on February 3, 2008, and ending on the date the patent issued, November 3, 2009. However, since the Applicants filed a request for continued examination (RCE) on December 3, 2008, the total B delay ended on December 3, 2008, which is calculated to be 304 days.

Applicants delay

Applicants agree with the Office that under 37 CFR § 1.704 the delay caused by the applicant is 231 days. A total of 231 days has already been subtracted from the delay stated on the issued patent to arrive at the currently indicated 244 days of A delay.

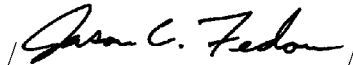
Overlapping period and total patent term adjustment

According to § 1.703(f), the term of a patent is entitled to adjustment under § 1.702 and the term shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section, to the extent that such periods are not overlapping, less the sum of the periods calculated under § 1.704.

In Wyeth v. Dudas, the US district court for DC held that the only way periods of time can “overlap” is if the A and B delays occur on the same day, and that the B delay begins when the PTO has failed to issue a patent within three years, not before.¹ Here, the overlap period determined according to the holding in Wyeth is 33 days, from August 1, 2008 to September 3, 2008. Applicant contends that the total patent term adjustment the above patent is entitled to, as explained herein, should be 515 days ($475 + 304 - 33 - 231 = 515$). Applicant is mindful that the Office is appealing the Wyeth v. Dudas decision and has taken the position that a patent is only entitled to the longer of the A and B delays, not the sum of the two.

Applicants submit that in view of the foregoing, the subject patent is entitled to a total of 515 days of patent term adjustment, which would be an additional 271 days of adjustment over the 244 days stated on the issue notification. Applicants hereby respectfully request reconsideration of the patent term adjustment of the above-referenced patent. If a telephone conference would help the Office determine this matter, the Office is encouraged to call the undersigned attorney.

Respectfully submitted,



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¹ Weyth v. Dudas, 580 F. Supp. 2d 138, 142.